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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT

PAPER NUMBER

2617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/341,324	Applicant(s) KOGA ET AL.	
	Examiner JOY K. CONTEE	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 57-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 58-66 is/are rejected.
- 7) ☒ Claim(s) 57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/19/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1,2 and 57-66 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 2,58 and 63-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 2, 58 and 63-66 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, independent claim 2, claims in the preamble "A transmitting method, comprising" and lists in the body of the claim, a

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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process for supplying, multiplexing and transmitting, without positively reciting the other statutory class, i.e., a transmitting apparatus to which the process or method is tied.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rovira et al. (Rovira), US Patent No. 5,239,540, previously used, in view of Boden, US 633,686, in further view of Glaser et al. (Glaser), US Pub. No. 2006/0271989.

Regarding claim 1, Rovira discloses a transmitting apparatus, comprising:

a plurality of audio channel material supplying means for supplying a plurality of broadcast audio materials formed of digital audio data (col. 3, lines 57-67);

data supplying means for supplying digital data for an audio information screen associated with one or more of the broadcast audio materials, said digital data including interactive GUI data used to generate an interactive on-screen display to allow interaction between the user and the display (col. 5, line 28 and col. 9, line 40 to col. 10, line 68 and Figs. 1 & 8).

download audio data supplying means for supplying download audio data corresponding to the one or more of the broadcast audio materials that are compressed in a predetermined compressing format (col. 4, lines 32 to col. 5, line 28 and col. 9, line 40 to col. 10, line 68 and Figs. 1 & 8).

Rovira fails to explicitly disclose multiplexing means for multiplexing the digital audio data of the plurality of audio broadcasts, the associated digital data for the audio information screen and the corresponding download audio data to form multiplexed data having an audio broadcast component, a digital data for audio information screen component, and a download audio data component.

In addition Boden discloses wherein the multiplexing means for multiplexing the digital audio data of the plurality of audio broadcasts, the associated digital data for the audio information screen and the corresponding download audio data to form multiplexed data having an audio broadcast component, a digital data for audio information screen component, and a download audio data component (see col. 3, lines 57-67 and col. 4, lines 31 to col. 5, line 28 and col. 9, line 40 to col. 10, line 68 and Figs. 1 and 8).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Rovira to include wherein the multiplexing means for multiplexing the audio digital data of the plurality of audio broadcasts, the digital data for the audio information screen corresponding to the transmitted audio broadcast, and the download audio data for the purpose of providing an adaptive encoding scheme independent of video format.

The combination of Rovira and Boden fail to explicitly disclose transmitting means for transmitting the multiplexed data such that each one of the audio broadcast component, the digital data for audio information screen component and the download audio data component is transmitted completely at least twice within a program period.

In a similar field of endeavor, Glaser discloses transmitting means for transmitting the multiplexed data such that each one of the audio broadcast component, the digital data for audio information screen component and the download audio data component is transmitted completely at least twice within a program period (i.e., reads on user requesting audio clip from table of contents and accessing audio clip in the advance buffer to playback the audio data) (see pages 1-2 [0010, 0013] and page 3 [0028] and page 11 [0090] and page 13 [0106] and pages 14-15 [0109, 0113] and [0114,0118]).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Rovira to include audio data which is downloadable and for replaying selected titles of the audio broadcast materials of the audio digital data for the purpose of providing a subscriber with selectable audio information when demanded and at higher quality if chosen (see Glaser, page 1 [006] and page 2 [0013] and page 3 [0028]).

Regarding claim 59, Rovira, Boden and Glaser disclose the transmitting apparatus of claim i, wherein the plurality of broadcast audio materials includes a plurality of audio channel programs (see Glaser, page 1 [0006] and page 2 [0013] and page 3 [0028]).

Regarding claim 60, Rovira, Boden and Glaser disclose the transmitting apparatus of claim 1, wherein the plurality of broadcast audio materials includes a plurality of music titles (see Glaser, page 1 [0006] and page 2 [0013] and page 3 [0028]).

Regarding claim 61, Rovira, Boden and Glaser disclose the transmitting apparatus of claim 60, wherein the associated digital data for the audio information screen

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includes at least one of a list of the plurality of music titles, information concerning the plurality of music titles, or an electronic program guide(see Glaser, page 1 [0006] and page 2 [0013] and page 3 [0028]).

Regarding claim 62, Rovira, Boden and Glaser disclose the transmitting apparatus of claim 60, wherein the corresponding download audio data includes the plurality of music titles(see Glaser, page 1 [0006] and page 2 [0013] and page 3 [0028]).

Allowable Subject Matter

6. Claim 57 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOY K. CONTEE whose telephone number is (571)272-7906. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571.272.7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JC

/Charles N. Appiah/
Supervisory Patent Examiner, Art Unit 2617